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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,619	04/19/2004	Takanori Fujii	2271/72198	7291
23432 7590 05/07/2008 COOPER & DUNHAM, LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER BECKLEY, JONATHAN R				
ART UNIT 2625		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/829,619

**Applicant(s)**

FUJII, TAKANORI

**Examiner**

JONATHAN R. BECKLEY

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-11 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-850)  
Paper No(s)/Mail Date 04/19/2004  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-11 are rejected under 35 U.S.C. 103(a)** as being unpatentable over obviousness by **Kawabata et al. (US 2004/0057568 A1)** in further view of **Tanimoto (US Patent 7,142,320)**.
3. Regarding **Claim 1**, **Kawabata** teaches a facsimile apparatus (**communications terminal unit**) that is connected to a network (**Paragraph 3, lines 1-3**) and has an ITU-T recommendation T.37 full-mode function for facsimile transmission of an image file processed by an image processor using parameters corresponding to a transmission mode (**Paragraph 31, lines 17-21**), the facsimile transmission being carried out via the network (**Paragraph 31, lines 24-28**), the facsimile apparatus comprising: a destination information memory that stores one of reception capacity information of a selected transmission destination and reception capacity information of the selected transmission destination contained in delivery confirmation mail sent from the selected transmission destination (**Paragraph 47, lines 1 – Paragraph 48, line5**), the reception capacity information being associated with the mail address of the selected transmission

destination (**Paragraph 47, lines 1-9**); a transmission mode memory that stores the transmission mode used for the facsimile transmission accompanied by the delivery confirmation request (**Paragraph 50, lines 1-6**); and a controller (**Communication Terminal Unit, element 10**) that causes the transmission mode memory to store the transmission mode used for the facsimile transmission accompanied by the delivery confirmation request, (**Figure 3; Paragraph 45, line 1 – Paragraph 50, line 6**).

**Kawabata** does not directly teach a facsimile apparatus with at least with a delivery confirmation request being attached to the image file, and causes the destination information memory to store reception capacity information contained in the delivery confirmation mail sent from the selected transmission destination, the reception capacity information being stored as the reception capacity information of the selected transmission destination, and causes the destination information memory to store the transmission mode, already stored in the transmission mode memory, as a transmission enabling mode of the selected transmission destination when the delivery confirmation mail does not contain the reception capacity information but confirms that the communication has been properly completed.

**Kawabata combined with Tanimoto** does teach a facsimile apparatus with at least with a delivery confirmation request being attached to the image file, the facsimile transmission being carried out via the network (**Column 6, lines 44-53**), and

a controller causes the destination information memory to store (**Column 5, lines 51-53**) reception capacity information (**receiving ability, Column 6, lines 15-22**)

contained in the delivery confirmation mail sent from the selected transmission destination (**Column 6, lines 54-59**) , the reception capacity information being stored as the reception capacity information of the selected transmission destination, and causes the destination information memory to store the transmission mode (**Column 6, lines 15-28**), already stored in the transmission mode memory, as a transmission enabling mode of the selected transmission destination when the delivery confirmation mail does not contain the reception capacity information but confirms that the communication has been properly completed (**Column 1, lines 22-26; and Column 9, line 54 – Column 10, line 5**) .

Kawabata and Tanimoto are combinable because they are both from the same art of communicating/facsimile apparatuses and methods of the same.

Therefore, it would have been obvious to one skilled in the art to modify Kawabata with the teachings of Tanimoto, so to provide a communication apparatus such as an internet facsimile machine to be capable to grasp a substantial communication record and information easily, even when an image data is transmitted by using an ability exchanging function. (See SUMMARY OF INVENTION)

Regarding **Claim 2, Kawabata combined with Tanimoto** further discloses the controller causes the destination information memory to store the transmission mode, which has already been stored in the transmission mode memory, as a transmission disabling mode of the selected transmission destination, when the delivery confirmation mail sent from the selected transmission destination does not contain the reception

capacity information but confirms that the communication failed (**Kawabata :Paragraph 47, lines 3-9**).

Regarding **Claim 3, Kawabata combined with Tanimoto** further discloses an image memory that stores image files for transmission (**Kawabata :Paragraph 31, lines 8-10**); wherein when an image file that has been processed by the image processor using parameters different from default parameters is facsimile-transmitted at least together with the delivery confirmation request (**Kawabata :Paragraph 31, lines 10-12**), the controller keeps the image file in the image memory until the delivery confirmation mail is sent from the selected transmission destination (**Kawabata :Paragraph 31, lines 12-14**), and when delivery confirmation mail is sent from the selected transmission destination reporting that the communication failed, the image processor converts the image file kept in the image memory into an image file corresponding to the default parameters, and the converted image file is facsimile-transmitted again to the selected transmission destination (**Kawabata :Paragraph 47, lines 1-9**).

Regarding **Claim 10, Kawabata combined with Tanimoto** further discloses an image memory that stores image files for transmission, wherein the controller determines said transmission mode for said facsimile transmission, and when the transmission mode corresponds to a transmission enabling mode, regular transmission is carded out and the transmitted image file is deleted from the image memory (**Tanimoto: See flow of Figure 16**)

Regarding **Claim 11, Kawabata combined with Tanimoto** further discloses wherein if the transmission mode stored in the destination information memory for the selected transmission destination is neither a transmission disabling mode nor a transmission enabling mode, said controller, prior to transmission, stores the image file in an image memory and attaches a delivery confirmation request to said image file for transmission (**Tanimoto: Column 12, lines 48-55**)

Regarding **Claim 4**, Kawabata teaches a facsimile apparatus (**communications terminal unit**) that is connected to a network (**Paragraph 3, lines 1-3**) and has an ITU-T recommendation T.37 full-mode function for facsimile-transmitting an image file processed by an image processor using parameters corresponding to a transmission mode (**Paragraph 31, lines 17-21**), the facsimile transmission being carried out via the network (**Paragraph 31, lines 24-28**), the facsimile apparatus comprising: means for storing one of reception capacity information of a selected transmission destination and reception capacity information of the selected transmission destination contained in delivery confirmation mail sent from the selected transmission destination (**Paragraph 47, line 1 – Paragraph 48, line 5**), the reception capacity information being associated with the mail address of the selected transmission destination (**Paragraph 47, lines 1-9**); means for storing the transmission mode used for the facsimile transmission accompanied by the delivery confirmation request (**Paragraph 50, lines 1-6**); and

means for controlling the transmission mode storing means to store the transmission mode used for the facsimile transmission accompanied by the delivery confirmation request, **(Figure 3; Paragraph 45, line 1 – Paragraph 50, line 6)**.

**Kawabata** does not directly teach a facsimile apparatus with at least with a delivery confirmation request being attached to the image file, and

means for controlling the destination information storing means to store reception capacity information contained in the delivery confirmation mail sent from the selected transmission destination, the reception capacity information being stored as the reception capacity information of the selected transmission destination, and controlling the destination information storing means to store the transmission mode, already stored in the transmission mode storing means, as a transmission enabling mode of the selected transmission destination when the delivery confirmation mail does not contain the reception capacity information but confirms that the communication has been properly completed.

**Kawabata combined with Tanimoto** does teach a facsimile apparatus with at least with a delivery confirmation request being attached to the image file, the facsimile transmission being carried out via the network **(Column 6, lines 44-53)**, and

means for controlling the destination information storing means to store **(Column 5, lines 51-53)** reception capacity information **(receiving ability, Column 6, lines 15-22)** contained in the delivery confirmation mail sent from the selected transmission destination **(Column 6, lines 54-59)** , the reception capacity information being stored as the reception capacity information of the selected transmission destination, and



controlling the destination information storing means to store the transmission mode **(Column 6, lines 15-28** already stored in the transmission mode storing means, as a transmission enabling mode of the selected transmission destination when the delivery confirmation mail does not contain the reception capacity information but confirms that the communication has been properly completed. **(Column 1, lines 22-26; and Column 9, line 54 – Column 10, line 5).**

Kawabata and Tanimoto are combinable because they are both from the same art of communicating/facsimile apparatuses and methods of the same.

Therefore, it would have been obvious to one skilled in the art to modify Kawabata with the teachings of Tanimoto, so to provide a communication apparatus such as an internet facsimile machine to be capable to grasp a substantial communication record and information easily, even when an image data is transmitted by using an ability exchanging function. (See SUMMARY OF INVENTION)

Regarding **Claim 5, Kawabata combined with Tanimoto** further discloses the controlling means causes the destination information storing means to store the transmission mode, which has already been stored in the transmission mode storing means, as a transmission disabling mode of the selected transmission destination, when the delivery confirmation mail sent from the selected transmission destination does not contain the reception capacity information but confirms that the communication failed **(Kawabata :Paragraph 47, lines 3-9).**

Regarding **Claim 6, Kawabata combined with Tanimoto** further discloses means for storing image files for transmission (**Kawabata :Paragraph, lines 8-10**); wherein when an image file that has been processed by the image processor using parameters different from default parameters is facsimile-transmitted at least together with the delivery confirmation request (**Kawabata :Paragraph 31, lines 10-12**), the controller keeps the image file in the image storing means until the delivery confirmation mail is sent from the selected transmission destination (**Kawabata :Paragraph, 31, lines 12-14**), and when delivery confirmation mail is received from the selected transmission destination reporting that the communication failed, the image processor converts the image file kept in the image storing means into an image file corresponding to the default parameters, and the converted image file is facsimile-transmitted again to the selected transmission destination (**Kawabata :Paragraph 47, lines 1-9**).

Regarding **Claim 7, Kawabata** teaches a method of facsimile transmission using a facsimile apparatus (**communications terminal unit**) that is connected to a network (**Paragraph 3, lines 1-3**) and has an ITU-T recommendation T.37 full-mode function for facsimile transmission of an image file processed by an image processor using parameters corresponding to a transmission mode (**Paragraph 31, lines 17-21**), the facsimile transmission being carried out via the network (**Paragraph 31, lines 24-28**), the method comprising the steps of: storing one of reception capacity information of a selected transmission destination and reception capacity information of the selected

transmission destination contained in delivery confirmation mail sent from the selected transmission destination, the reception capacity information being associated with the mail address of the selected transmission destination and being stored in a destination information memory (**Paragraph 47, line 1 – Paragraph 48, line 5**); storing the transmission mode used for the facsimile transmission accompanied by the delivery confirmation request in a transmission mode memory (**Paragraph 50, lines 1-6**); controlling; and controlling the destination information memory to store the transmission mode, already stored in the transmission mode memory, (**Figure 3; Paragraph 45, line 1 – Paragraph 50, line 6**).

**Kawabata** does not directly teach a facsimile apparatus with at least with a delivery confirmation request being attached to the image file, and

controlling the destination information memory to store reception capacity information that is contained in the delivery confirmation mail sent from the selected transmission destination, the reception capacity information being stored as the reception capacity information of the selected transmission; and controlling the destination information memory to store the transmission mode, already stored in the transmission mode memory, as a transmission enabling mode of the selected transmission destination, when the delivery confirmation mail does not contain the reception capacity information but confirms that the communication has been properly completed

**Kawabata combined with Tanimoto** does teach a facsimile apparatus with at least with a delivery confirmation request being attached to the image file, the facsimile transmission being carried out via the network **(Column 6, lines 44-53)**, and

controlling the destination information memory to store **(Column 5, lines 51-53)** reception capacity information **(Column 6, lines 15-2; receiving ability)** that is contained in the delivery confirmation mail sent from the selected transmission destination, the reception capacity information being stored as the reception capacity information of the selected transmission **(Column 6, lines 54-59)**; and controlling the destination information memory to store the transmission mode **(Column 6, lines 15-28)**, already stored in the transmission mode memory, as a transmission enabling mode of the selected transmission destination, when the delivery confirmation mail does not contain the reception capacity information but confirms that the communication has been properly completed **(Column 1, lines 22-26; and Column 9, line 54 – Column 10, line 5)**

Kawabata and Tanimoto are combinable because they are both from the same art of communicating/facsimile apparatuses and methods of the same.

Therefore, it would have been obvious to one skilled in the art to modify Kawabata with the teachings of Tanimoto, so to provide a communication apparatus such as an internet facsimile machine to be capable to grasp a substantial communication record and information easily, even when an image data is transmitted by using an ability exchanging function. (See SUMMARY OF INVENTION)

Regarding **Claim 8, Kawabata combined with Tanimoto** further discloses storing in the destination information memory information indicating the transmission mode used for the facsimile transmission accompanied by the delivery confirmation request (**Tanimoto :Column 8, line 64 – Column 9, line 8**), as a transmission disabling mode of the selected transmission destination, when the delivery confirmation mail from the selected transmission destination does not contain the reception capacity information and confirms that the communication has failed (**Tanimoto :See Figure 15, S55, S52 and S59; and Figure 16, S153 and S154**) .

Regarding **Claim 9, Kawabata combined with Tanimoto** further discloses storing in an image memory an image file processed using parameters different from default parameters, until said delivery confirmation mail is received from said selected transmission destination (**Tanimoto :See Figure 16, S156-S163**);

converting said image file kept in said image memory into a converted image file corresponding to said default parameters, ff said delivery confirmation mail received from the selected transmission destination indicates that the communication failed (**Tanimoto :See Figure 16, S156-S154**);; and

transmitting the converted image file to the selected transmission destination (**Tanimoto: Column 7, lines 33-59**).

***Response to Arguments***

Applicant's arguments with respect to claims 1, 4 and 7 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN R. BECKLEY whose telephone number is (571)270-3432. The examiner can normally be reached on Mon-Fri: 7:30-5:00 EST (Alternate Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TWYLER L. HASKINS can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2625

/Jonathan R Beckley/  
Examiner, Art Unit 2625

/J. R. B./  
Examiner, Art Unit 2625  
4/25/2008

/Twyler L. Haskins/  
Supervisory Patent Examiner, Art Unit 2625